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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,210	11/13/2001	Reinhard Deutsch	31976-175930	6730

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EXAMINER

TRUONG, THANH K

ART UNIT	PAPER NUMBER
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3721

DATE MAILED: 08/01/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	09/987,210	DEUTSCH ET AL.	
	Examiner	Art Unit	
	Thanh K Truong	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 11-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All   b) ☐ Some \*   c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. This action is in response to applicant's amendment, Paper No. 5, received on June 30, 2003.

#### ***Election/Restrictions***

2. Applicant's election with traverse of Group I, claims 1-10, in Paper No. 5 is acknowledged. The traversal is on the ground(s) that "no undo burden would be placed on the examiner by examining all pending claims". This is not found persuasive because these inventions are distinct for the reasons given on previous Office Action (paper no. 4) and have acquired a separate status in the art as shown by their different classification and by their recognized divergent subject matter, restriction for examination purposes as indicated is proper. (MPEP § 808.02).

Claim 21 is drawn to a nonelected invention; an apparatus for manipulating blanks in a machine for packing smoker's products.

The claim is distinct from the elected invention because it can be shown that the process as claimed can be practiced by another materially different apparatus such as the one that the conveying means does not include at least one wheel and at least one suction head on the at least one wheel.

The requirement is still deemed proper and is therefore made FINAL.

3. Claims 11-21 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Drawings***

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the features in the following recitations:

“the steps of delivering to said station a series of successive packs, positioning each pack at said station in a manner such that at least a portion of a blank at said station is disposed between the pack and a collar, and jointly evacuating the pack, the blank and the respective collar from said station” in claim 3, lines 1-4, and

“delivery of each of said series of successive packs to said station” in claim 6, lines 2-3, and

“wherein said evacuating step further includes introducing each pack, together with a blank and a collar, into a pocket of an indexible packing conveyor” in claim 7, lines 1-3,

must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

✓ Claim 5 recites the limitation "the application of pressure" in lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 6, it is unclear whether the evacuating step occurs simultaneously with the terminating of the step of positively guiding. It seems (from the specification) the terminating of the step of positively guiding happened before the evacuating step.

#### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1, 3, 8 and 9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17-19, 21 and 22 of copending Application No. 09/986,962. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to omit the specific elements from the copending application claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Spada et al. (5,657,609).

Spada discloses a method of manipulating blanks in a machine for packing smokes' products comprising the steps of:

transporting successive collars 3 of a series of collars from a source to the assembling station (column 5, lines 5-9); and

conveying successive blanks 4 (coupon) from the magazine, along a predetermined path, and on to the assembling station 13 so that each blank 4 reaches

the station while a collar 3 is at a standstill position (at substation B, the collar 3 is standing still before the blank 4 is being inserted), including positively guiding each blank at least along a portion of the path (the blank is inherently being positively guided along the path of conveyor 15' in order to be inserted to the collar in a precise manner).

Spada further discloses:

The steps of delivering to the assembly station a series of successive packs 12 (column 4, lines 53-56), positioning each pack at the station in a manner such that at least a portion of a blank at the station is disposed between the pack and a collar, and jointly evacuating the pack, the blank and the respective collar from the station (column 6, lines 7-10).

The terminating step includes an application of pressure (pusher 16') to the blank at the assembly station 13 (column 5, lines 40-41).

The evacuating step includes terminating the step of positively guiding upon completed delivery of each of the series of successive packs to the assembly station (column 6, lines 1-5).

The evacuating step further includes introducing each pack, together with a blank and a collar, into a pocket of an indexable packing conveyor (column 6, lines 10-26).

Each of the conveying steps includes conveying a blank to a position beneath the collar at the assembly station (at substation B, blank 4 is positioned beneath the collar 3 in view of the conveying means 15').

The guiding step includes simultaneously guiding several portions of a blank in the portion of the path 15'.

### ***Conclusion***

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K Truong whose telephone number is (703) 605-0423. The examiner can normally be reached on Mon-Thurs from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on (703) 308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 872-9301.



Rinaldi I. Rada  
Supervisory Patent Examiner  
Group 3700

tkr  
July 28, 2003